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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,291	02/11/2002	Patrice J. McCune	MA-12918	2439

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EXAMINER

VO, HAI

ART UNIT PAPER NUMBER

1771

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/071,291	MCCUNE, PATRICE J.	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,8-15 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8-15 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 14 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Ramesh et al (US 6,391,438). Ramesh teaches a foam/film composite structure placed on airplane wings to facilitate servicing of the aircraft comprising a thin, continuous, polyolefin top film and a bottom continuous foam layer being adhered to the polyolefin top film by coextrusion process (figures 1 and 2). The foam/film composite structure having a coefficient of friction ranging from 0.5 to 2.0 as measured at the upper surface of the film (abstract) making it suitable for non-skid foams. Likewise, the foam/film composite structure is a non-slip sheet material too! The foam/film composite structure exhibits an aesthetically pleasing appearance and no scuffing (column 9, lines 45-46). It appears that the foam layer is made of a polyethylene; therefore, the foam layer is non-reactive and free of plasticizers. The foam layer is about 1 to 80 mils, within the claimed range (column 3, line 20). The top film has a thickness from 3 to 6 mils, within the claimed range (column 4, line 10). The top film can be laminated to the foam layer via a primer (column 6, lines 40-41). It appears that the foam/film

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composite structure of Ramesh meets all the structural limitations as required by the claims, a top plastic film adhered to a bottom foam layer. The composite structure is a non-slip sheet material. Both the film layer and the foam layer have the thickness within the claimed ranges. It is not seen that the composite structure of Ramesh would have performed differently from the sheet material of the present invention with respect to resiliency, flexibility, curling resistance. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete (*In re Spada*, 15 USPQ 2d 1655 (1990)). Ramesh does disclose the foam/film composite structure having been used in packaging applications. Ramesh is silent as to the use of the composite structure for covering a household surface. It appears that the foam/film composite structure of Ramesh meets all the structural limitations as required by the claims, a top plastic film adhered to a bottom foam layer. The composite structure is a non-slip sheet material. Both the film layer and the foam layer have the thickness within the claimed ranges. It is noted that covering a household surface is not part of the sheet material structure but rather an intended use as recited in the claims. It has been held that a recitation with respect to the manner in which a claimed sheet material is intended to be employed does not differentiate the claimed sheet material from a prior art foam/film composite structure satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Accordingly, it is the examiner's position that Ramesh anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 9, 15 and 32 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ramesh et al (US 6,391,438). See discussion in the paragraph no. 2. Ramesh is silent as to the foam being cast on the film. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Ramesh. It is the examiner's position that Ramesh anticipates or strongly suggests the claimed subject matter.
5. Claims 5, 6, 10, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramesh et al (US 6,391,438) as applied to claim 1 above, further in view of Cougar (US 6,216,819). Ramesh does not specifically disclose that the foam/film composite structure for use on airplane wings to facilitate servicing of the aircraft comprises a foam layer made of rubber or styrene butadiene foam. Cougar, however, teaches a kneeling board 10 comprising a

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rigid board element 12 and an anti-slip pad 14 attached to an underside of the board element. Cougar teaches that the anti-slip pad is constructed of an open cell foam material of styrene-butadiene rubber with an density within the range disclosed in Ramesh for anti-slip purposes (column 4, lines 20-45). This is important to the expectation of successfully practicing the invention of Ramesh and therefore suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the styrene-butadiene rubber as a foam layer motivated by the desire to improve anti-slip characteristics of the composite structure, which is important to the expectation of successfully practicing the invention of Ramesh and therefore suggesting the modification.

6. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ramesh et al (US 6,391,438) as applied to claim 1 above, as evidenced by Fumei et al (US 4,016,327). Ramesh teaches a foam/film composite comprising a film layer fabricated from an ethylene/alpha-olefin copolymer (column 4, lines 46-47). Ramesh does not specifically disclose the alpha-olefin being propylene. Fumei is relied on as evidence that teaches the alpha-olefins simply being propylene (column 4, lines 58-59). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the ethylene/propylene copolymer as a film layer because such is a known and typical material of ethylene/alpha-olefin copolymer.

7. Claims 2, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramesh et al (US 6,391,438) in view of the prior art as admitted by Applicant at page 5, lines 11-16 of Applicant's specification (herein after referred to as the admitted prior art). Ramesh does not teach the plastic top film being impregnated with polycarbonate to provide skin characteristics on the surface of the film. However, Applicant admitted that the polycarbonate impregnation is part of commercially available polypropylene film when the film is ordered (page 5, lines 11-16 of Applicant's specification). Likewise, it is clearly apparent that the top film impregnated with polycarbonate to promote the adhesion is not first invented by Applicant but rather is accomplished by the film vendor. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the top plastic film having been pre-treated with polycarbonate prior to lamination to the bottom foam layer motivated by the desire to promote adhesion between the top plastic film layer and the bottom foam layer, which is important to the expectation of successfully practicing the invention of Ramesh, thus suggesting the modification.
8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramesh et al (US 6,391,438) in view of the admitted prior art, as applied to claim 2, further in view of Cougar (US 6,216,819). Ramesh does not specifically disclose that the foam/film composite structure for use on airplane wings to facilitate servicing of the aircraft comprises a foam layer made of rubber or styrene butadiene foam. Cougar, however, teaches a kneeling board 10

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comprising a rigid board element 12 and an anti-slip pad 14 attached to an underside of the board element. Cougar teaches that the anti-slip pad is constructed of an open cell foam material of styrene-butadiene rubber with an density within the range disclosed in Ramesh for anti-slip purposes (column 4, lines 20-45). This is important to the expectation of successfully practicing the invention of Ramesh and therefore suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the styrene-buradiene rubber as a foam layer motivated by the desire to improve anti-slip characteristics of the composite structure, which is important to the expectation of successfully practicing the invention of Ramesh and therefore suggesting the modification.

Drawings

9. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "16a" of figure 5 has been used to designate both top dashed line and bottom dashed line. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

REVISED AMENDMENT

10. Applicant is reminded that the current status of all of the claims must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled),

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(withdrawn), (new), (previously presented) and (not entered) in accordance with revised amendment practice. Appropriate correction is required.

Response to Arguments

11. The art rejections over Alderfer have been overcome by the present amendment and declaration filed on 11/25/2003. The declaration states that since the foam body of Alderfer is sectioned with a blade, the natural pores in the foam would exhibit an uneven, exposed, pocked surface. The foam body has a strong tendency to crumble and becomes dislodged from the exposed surface. Due to the sectioning process, the foam body of Alderfer would be likely to minimize the non-slip characteristic of the foam, which is a required characteristic in the sheet material of the claimed invention.
12. Applicant's arguments with respect to claims 1,2, 5, 6, 8-15, and 32-34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV

Hai Vo
TC 1700